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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91177234
Party	Plaintiff Cardinal Health 303, Inc.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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|------------------------------|---|------------------------------|
| 1. CARDINAL HEALTH 303, INC. | : | |
| Opposer | : | |
| v. | : | Opposition No.: 91-177,234 |
| THE ALARIS GROUP, INC. | : | |
| Applicant | : | |
| | : | |
| 2. CARDINAL HEALTH 303, INC. | : | |
| Opposer | : | |
| v. | : | Opposition No.: 91-177,365 |
| THE ALARIS GROUP, INC. | : | |
| Applicant | : | |
| | : | |
| 3. CARDINAL HEALTH 303, INC. | : | |
| Opposer | : | |
| v. | : | Opposition No.: 91-177,366 |
| THE ALARIS GROUP, INC. | : | |
| Applicant | : | |
| | : | |
| 4. CARDINAL HEALTH 303, INC. | : | |
| Opposer | : | |
| v. | : | Opposition No.: 91-177,367 |
| THE ALARIS GROUP, INC. | : | |
| Applicant | : | |
| | : | |
| 5. CARDINAL HEALTH 303, INC. | : | |
| Petitioner | : | |
| v. | : | Cancellation No.: 92-048,172 |
| THE ALARIS GROUP, INC. | : | |
| Registrant. | : | |

**CARDINAL HEALTH 303, INC.'S MEMORANDUM IN OPPOSITION
TO THE ALARIS GROUP, INC.'S MOTION FOR SUMMARY JUDGMENT**

REDACTED

INTRODUCTION

These consolidated proceedings have been pending for less than one year -- the Notices of Opposition were filed in May of 2007 and the Petition for Cancellation was filed in September of 2007. Not surprisingly, discovery is in its early stages, and no discovery depositions have been conducted by either party. Petitioner/Opposer Cardinal Health 303, Inc. ("Cardinal") has responded to two sets of interrogatories and two sets of document requests, producing thousands of pages of documents and extensive, detailed interrogatory responses. Registrant/Applicant The Alaris Group, Inc. ("Alaris Group") has provided perfunctory responses to one set of interrogatories and one set of document requests, producing less than one hundred fifty pages of documents, inclusive of the pleadings in this case and the correspondence between counsel.

Based on this "record," Alaris Group has filed a kitchen-sink, jumbled Motion for Summary Judgment that not only seeks to have all of these actions dismissed on the grounds of laches, but includes a remarkable *four* motions in the alternative – a motion for leave to amend its answer to add a *Morehouse* affirmative defense, a discovery order (or, alternatively) a motion for sanctions, and a motion seeking leave to add a counterclaim seeking to cancel Cardinal's registration of ALARIS for fraud. However, Alaris Group fails to mention anywhere in its Motion that it has refused to grant extensions of time to produce discovery, served additional discovery two weeks prior to Christmas and refused to consent to an extension of time to produce, has failed to consult over alleged failures to respond to discovery, has failed to include a party signature attesting to veracity of its *own* answers to interrogatories, and even misrepresents to this Board that Cardinal has failed to respond to Alaris Group's second set of discovery requests. It also neglects to mention that the parties were engaged in settlement negotiations for six months before these actions were filed. Clearly, Alaris Group is desperate to

have this Board find some grounds to avoid having to decide the real issue – its use of the identical mark ALARIS is likely to result in confusion with respect to Cardinal’s medical products and services and Alaris Groups’ medical services.

STATEMENT OF FACTS

While few details have come to light due to the lack of discovery completed to date, Alaris Group appears to have begun life in 1999 as a five-person consulting company focused on the worker’s compensation industry. [Alaris Group’s Bf. at Pg. 5.; Caven Decl. ¶ 4 (noting that Alaris Group’s various marks have consistently been used with “consulting services in the fields of medical and vocational rehabilitation primarily responding to the needs of the worker’s compensation industry”).] Over time, Alaris Grown has grown and changed its business — including expansion geographically, the addition of new goods and services, and changes in the names used to brand its goods and services. [Caven Decl. ¶ 5–8].

Alaris Group was aware of Cardinal’s trademarks, including its registration of the mark ALARIS for a wide variety of goods and services in the medical field, at least as early as November 17, 2000 [Alaris Group 0007–0018]. Despite this knowledge, Alaris Group chose to shorten its name from THE ALARIS GROUP, INC. to ALARIS and obtained a new federal registration for the new mark on March 8, 2005. [Alaris Group Bf. at Pg. 3 (denoting The Alaris Group, Inc. as the mark of its “initial adoption”); Caven Decl. ¶ 5(c)]. Along with changing the mark, Alaris Group revised its identification of services; whereas they formally read “consulting services...” they were revised in the new registration to be “medical consulting services...” [Caven Decl. ¶5(c) (acknowledging that the new mark for the single word ALARIS was registered for “medical consulting services....”(emphasis added))]. Later that same year, Alaris

Group filed another trademark application for yet another new name, ALARIS SELECT, which also adopted the new wording “medical consulting services...” [Caven Decl. ¶ 6].

In 2006, the owners of the Alaris Group undertook a strategic initiative to expand geographically via the franchise model. [Caven Decl. ¶ 8]. Also in 2006, and in anticipation of and/or coinciding with its impending franchise business, Alaris Group filed additional trademark applications for ALARIS, ALARIS ADVANTAGE, and ALARISWARE, all for goods and services in or related to the medical field. [Caven Decl. ¶ 8].

Cardinal became aware of the ALARIS SELECT application in early 2007 through its Counsel’s monitoring of the *Official Gazette*, and likewise learned of the ALARIS, ALARIS ADVANTAGE and ALARISWARE application upon their publication. [True Decl. ¶2]. Through subsequent research into the company’s activities in March of 2007, Cardinal learned of Alaris Group’s prior registration of ALARIS. [True Decl. ¶3]. After filing the appropriate extensions of time in which to oppose the four recent Alaris Group applications, Counsel for Cardinal contacted Counsel for Alaris Group to discuss possible settlement. [True Decl. ¶4]. On June 15, 2007, Counsel for Alaris Group proposed a “Mark Co-Existence Agreement.” [True Decl. ¶5]. Cardinal then filed its Notices of Opposition, but on August 2, 2007, consented to extend the Alaris Group’s time to answer, and further consented to extend the discovery, testimony and trial periods in order to give the parties additional time to discuss settlement. [True Decl. ¶6].

Cardinal’s current Counsel took over Cardinal’s representation in August 2007, and on August 24, 2007 wrote to Alaris Group’s Counsel with comments regarding the June 15, 2007 proposed co-existence agreement. [True Decl. ¶7]. Counsel for Alaris Group responded on September 10, 2007. [True Decl. ¶8]. By reply letter of September 14, 2007, Counsel for

Cardinal acknowledged that further settlement discussions were not going to be productive at that time, and the parties agreed to move forward with the Oppositions. [True Decl. ¶9]. The Petition to Cancel Registration No. 2930177 was filed shortly thereafter, along with a consented Motion seeking consolidation of these proceedings. Below is a summary of the time frame for the filing of each of the Cardinal actions:

Opposed Application	Publication Date	Extended Deadline to File Opposition	Filing of Notice of Opposition
ALARIS SELECT (SN: 78744914)	1/23/2007	5/23/2007 Per Order ESTTA125211	Filed on 5/10/2007 Opposition No. 91177234
ALARIS (SN: 78945352)	3/6/2007	7/4/2007 Per Order ESTTA128651	Filed on 5/17/2007 Opposition No. 91177367
ALARIS ADVANTAGE (SN: 78945025)	3/6/2007	7/4/2007 Per Order ESTTA128649	Filed on 5/17/2007 Opposition No. 91177365
ALARISWARE (SN: 78937067)	3/6/2007	7/4/2007 Per Order ESTTA128654	Filed on 5/17/2007 Opposition No. 91177366

Challenged Registration	Issue Date	Date of Actual Knowledge	Filing of Petition for Cancellation
ALARIS (RN: 2930177)	3/8/2005	3/2007	Filed on 9/25/2007 Cancellation No. 92048172

Argument

I. ALARIS GROUP'S MOTION FOR SUMMARY JUDGEMENT ON THE GROUNDS OF LACHES SHOULD BE DENIED BECAUSE IT FAILS TO DEMONSTRATE UNREASONABLE DELAY

A. Laches Does Not Apply To Opposition Proceedings

It is a well established Board principle that laches cannot begin to run until a mark is published for opposition. *DAK Industries, Inc. v. Daiichi Kosho Co., Ltd.*, 25 U.S.P.Q.2d 1622, citing *National Cable Television Ass'n v. American Cinema Editors, Inc.*, 937 F.2d 1572, 1581–82 (Fed. Cir. 1991).

In each of the four Opposition proceedings, Cardinal timely filed its Notices of Opposition within the extended period for doing so after the publication of each application. Therefore, the Board should apply *National Cable* and *DAK Industries* and deny Alaris Group's motion for summary judgment on its laches defense with respect to each of the above Opposition proceedings.

B. Cardinal Brought Its Cancellation Proceeding Within A Reasonable Period

It is equally well established that "in the absence of actual knowledge prior to the close of the opposition period, the date of registration is the operative date for calculating laches." *Jansen Enterprises, Inc. v. Rind*, 85 U.S.P.Q.2d 1104, 1114 (TTAB 2007), citing *Teledyne Technologies, Inc. v. Western Skyways, Inc.* 78 U.S.P.Q.2d 1203, 1210 (TTAB 2006).

In the present case, Cardinal began its investigation of the Alaris Group's use of the ALARIS mark in March of 2007 – only two years after the Reg. No. 2930177 issued on March 8, 2005. There is no evidence in the record that Cardinal had actual knowledge of the Registration No. 2930177 prior to the date of registration – indeed, the evidence is to the contrary: Cardinal did not have actual knowledge of Alaris Group's ALARIS registration until March of 2007, a mere six months before Cardinal filed its Notice of Cancellation. [True Decl. ¶3-9] And as set forth above, the six month period of time between Cardinal's first knowledge of the ALARIS registration and the filing of the Cancellation action was spent conducting an investigation of Alaris Group and attempting to reach a settlement.

While there is no hard and fast date for the application of the equitable defense of laches, the Board has indicated that periods of approximately three years (longer than the period in this case) do not *per se* establish laches. See *Plymouth Cordage Co. v. Solar Nitrogen Chemicals, Inc.*, 152 USPQ 202, 204 (TTAB 1966)(mere delay of three years, without more, insufficient); *Cosmair, Inc. v. Jean Alexander Cosmetics, Inc.*, Cancellation No. 26649, 2001 TTAB LEXIS

805, *20-21 (non-precedential)(same). The CCPA has indicated that a period as short as six months could never result in laches. *See Ralston Purina Co. v. Midwest Cordage Co.*, 373 F.2d 1015, 153 U.S.P.Q. 73 (CCPA 1967).

Cardinal's "delay" in bringing its Petition for Cancellation was reasonable, particularly because the time period between Cardinal having actual knowledge of the Alaris Group's ALARIS registration and filing the Petition was only six months, and in light of the parties' efforts to reach a settlement of all these actions during that time frame. At the very least, Alaris Group has failed to prove the absence of a genuine issue of material fact which would entitle it to a judgment as a matter of law on this issue. *See Green Spot (Thailand) Ltd. v. Vitasoy Int'l Holdings Ltd.*, Opposition No. 91165010, Pg. 2 (February 21, 2008). Because a finder of fact could reasonably find in Cardinal's favor, Alaris Group's motion for summary judgment must be denied.

C. Alaris Group's Progressive Encroachment Further Excuses Any Delay By Cardinal

Progressive encroachment is a recognized excuse for delay in bringing a Cancellation proceeding. *See Jansen Enterprises, Inc. vs. Rind*, 85 USPQ 2d 1104, 1111 & 1115-1117 (March 15, 2007)(although plaintiff brought cancellation proceeding nearly five years after the issuance of the challenged registration, delay was excused and laches did not apply due to progressive encroachment). In *Jansen Enterprises*, the Board surveyed the case law of the Federal Courts in the context of infringement suits and applied this standard in the context of a Cancellation proceeding. The Board noted that laches may not apply where plaintiff's action is brought in response to defendant beginning to use the mark in a different manner, using the mark on new goods or services lines, expanding its use geographically, and re-directing its business to more squarely compete with plaintiff. *See id.* at 1116 (citing *ProFitness Physical Therapy Center*

v. Pro-Fit Orthopedic and Sports Physical Therapy P.C., 314 F.3d 62, 65 USPQ2d 1195, 1199-1200 (2d Cir. 2002), *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 55 USPQ2d 1225 (5th Cir. 2000), and *Sara Lee Corp. v. Kayser-Roth Corp.*, 81 F.3d 455, 38 USPQ2d 1449 (4th Cir. 1996)).

In *Jansen Enterprises* the Board further noted that: “the rule of “encroachment” allows a “plaintiff to tolerate *de minimis* or low-level infringements and act promptly when a junior user either gradually edges into causing serious harm or suddenly expands or changes its mark. The law should not require a trademark owner to make a headlong rush to litigation.” *Id.* (citing McCarthy on Trademarks and Unfair Competition at § 31:21; Restatement (Third) of Unfair Competition, § 31, comment c (1995)). Indeed, “A reasonable businessman should be afforded some latitude to assess both the impact of another’s use of an allegedly infringing trademark as well as the wisdom of pursuing litigation on the issue.” *Id.* at 1117 (citing *Tandy Corp. v. Malone & Hyde, Inc.*, 769 F.2d 362, 226 USPQ 703 (6th Cir. 1985), *cert. denied*, 476 U.S. 1158, 106 S. Ct. 2277 (1986)).

1. A Genuine Issue of Material Facts Exists Whether the Initial Use of “The Alaris Group, Inc.” Was *De Minimis*

Alaris Group acknowledges in its moving papers that it began in 1999 as a five person company. [Alaris Group’s Bf. at Pg. 5.] Alaris Group has offered very few details, aside from a few pages of a financial spreadsheet and a few anecdotal expansion announcements, to demonstrate the nature, amount, and geographic scope of its business operations and marketing during the early periods of its operations. Notably, Alaris Group chooses to emphasize its recent sales statistics from 2005 and 2006 and provides much more detail with regard to these numbers than for the period from 1999 to 2005. [Caven Decl. ¶ 12 (Alaris Group 0155-0157) & ¶13(Alaris Group 0158)].

With regard to marketing, Nancy J. Caven declares on behalf of Alaris Group, without citing any supporting documents, that the company has invested a mere [REDACTED] total in marketing and promotion over and eight year period. [Caven Decl. ¶ 10]. Ms. Caven further state that the average annual increases from year to year over this period was [REDACTED]. [Caven Decl. ¶ 10]. Thus, by Ms. Caven's own reckoning, the bulk of Alaris Group's total investment in marketing its brand must have occurred in the past two to three years.

2. Alaris Group's Adoption of New Trademarks Incorporating the Term "Alaris" on a Broader Array of Goods and Services Brings Them More Squarely Into Conflict with Cardinal

Alaris Group has only recently begun to use and seek an exclusive trademark right for several marks that include the term ALARIS for an expanded line of goods and services. On March 8, 2005, more than five years after it began operations under the registered mark THE ALARIS GROUP, INC.,¹ Alaris Group obtained a new trademark registration for the single word ALARIS for use with medical consulting services. [Alaris Group Bf. at Pg. 3 (denoting The Alaris Group, Inc. as the mark of its "initial adoption"); Caven Decl. ¶ 4 (noting that Alaris Group's marks have consistently been used with "consulting services in the fields of medical and vocational rehabilitation primarily responding to the needs of the worker's compensation industry"); Caven Decl. ¶5(c) (acknowledging that the new mark for the single word ALARIS was registered for "medical consulting services..."(emphasis added)).]

In 2006, the owners of the Alaris Group undertook a strategic initiative to expand geographically via the franchise model. [Caven Decl. ¶ 8]. In connection with this strategic

¹ To the extent that Alaris Group relies upon the so-called *Morehouse* defense to calculate the laches period from the issuance of this earlier registration, this argument is legally wrong. An affirmative defense under *Morehouse* is separate and apart from a laches defense and must be separately raised in a defendant's Answer. See TBMP § 311.02(b) (listing various affirmative defenses). If not raised, it cannot be relied upon by defendant unless this pleading is amended pursuant to Fed. Civ. R. P. 15(a) or 15(b). See TBMP § 311.02(c). Moreover, "[a] party may not obtain summary judgment on an unplead issue...." TBMP § 314.

initiative, Alaris Group filed additional trademark applications for ALARIS, ALARIS ADVANTAGE, each listing franchise services related to medical consulting services. [Caven Decl. ¶ 8]. Alaris Group even filed an application on or about this time for ALARISWARE, for software related to medical consulting. [Caven Decl. ¶ 8].

This recent proliferation of uses of the term ALARIS on an ever increasing scope of goods and services more squarely brings Alaris Group's usage into conflict with Cardinal's use of the mark ALARIS for a wide variety of goods and services sold in the medical field.

II. LEAVE TO AMEND ALARIS GROUP'S ANSWER TO ADD A MOREHOUSE AFFIRMATIVE DEFENSE SHOULD BE DENIED AS UNTIMELY AND FUTILE

A. Alaris Group Has Waived the *Morehouse* Affirmative Defense

Except as provided for in Fed. R. Civ. P. 12(b) & (h)(2), parties are required to bring all affirmative defenses in their first responsive pleading. See Fed. R. Civ. P. 12(b); TBMP § 311.02(c). If unpleaded, affirmative defenses may not be relied upon unless defendant amends its pleading under Fed. R. Civ. P. 15(a) or (b). TBMP § 311.02(c).

Alaris Group has obviously been aware of its own registration of THE ALARIS GROUP, INC. prior to the institution of the instant proceedings. This is not a case of a defendant seeking to amend its pleadings to conform to the evidence, as allowed under Fed. R. Civ. P. 15(b).

Moreover, Alaris Group's six month delay in seeking leave to add this defense to its answer under Fed. R. Civ. P. 15(a) appears to be wholly unjustified. The timing in this motion, packaged it together with a motion for summary judgment and a litany of other motions in the alternative, appears primarily designed to shift the focus away from the underlying issue of likelihood of confusion. Justice does not require the appeasement of parties who engage in such conduct, especially where, as here, the defense sought to be added is completely futile.

B. The *Morehouse* Affirmative Defense Would be Futile in the Present Case Because Alaris Group Cannot Possibly Meet the “Same or Substantially Identical” Standard For Both the Marks and the Goods/Services

“The *Morehouse* defense is an equitable doctrine that applies where an applicant owns a prior registration for essentially the same mark identifying essentially the same goods (or services) that are the subject mark and goods of the proposed application... In such a case, the opposer cannot be further injured....” *Green Spot (Thailand) Ltd. v. Vitasoy Int'l Holdings Ltd.*, Opposition No. 91165010, Pg. (February 21, 2008)(citing *Morehouse Manufacturing Corp. v. Strickland & Co.*, 407 F.2d 881, 160 USPQ 715 (CCPA 1969)(rejecting *Morehouse* defense where marks where Chinese version of mark not essentially the same as the American version).

In order for the *Morehouse* defense to apply, both the marks and the goods/services of the defendant's relied upon registration and its challenged application or registration must be “the same or substantially identical.” *Teledyne Technologies, Inc. v. Western Skyways, Inc.*, 78 U.S.P.Q.2D 1203, 1209 (2006). This standard should not be confused with the broader likelihood of confusion factors of “similarity of the marks” or “relatedness of the goods/services.” Indeed, the very narrow “same or substantially identical” standard necessary for application of *Morehouse* has been routinely found unmet by defendants who attempt to stretch their existing registration for slightly different marks or related but not identical goods. See, e.g., *Teledyne Technologies, Inc.*, 78 U.S.P.Q.2D at 1209 (rejecting *Morehouse* defense where goods were related but not substantially identical); *O-M Bread, Inc. v. United States Olympic Committee*, 65 F.3d 933, 36 USPQ2d 1041, 1045 (Fed. Cir. 1995); *La Fara Importing Co. v. F. Lil de Cesso di Filippo Fara S. Martino S.p.A.*, 8 USPQ2d 1143, 1147 (TTAB 1988); *Mason Engineering and Design Corp. v. Mateson Chemical Corp.*, 225 USPQ 956, 961 (TTAB 1985); *Liberty & Co., Ltd. v. Liberty Trouser Co. Inc.*, 216 USPQ 65, 68 (TTAB 1982). *Liberty & Co., Ltd. v. Liberty Trouser Co. Inc.*, 216 USPQ 65, 68 (TTAB 1982); *Jacks-Evans*

Manufacturing Co. v. Jaybee Manufacturing Corp., 481 F.2d 1342, 179 USPQ 81, 82–83 (CCPA 1973); *Key Chemicals, Inc. v. Kelite Chemicals Corp.*, 464 F.2d 1040, 175 USPQ 99, 101 (CCPA 1972)).

1. The *Morehouse* Defense Cannot Apply Because THE ALARIS GROUP, INC. is Not “The Same or Substantially Identical” to ALARIS, ALARIS SELECT, ALARIS ADVANTAGE, or ALARISWARE

In the present case, Alaris Group implies that its later “Alaris”-based marks are somehow grandfathered in under its earlier registration of THE ALARIS GROUP, INC. simply because the inclusion of the term ALARIS in the earlier registration means it is entitled to any mark using this term. This is an incorrect and overbroad interpretation of the *Morehouse* defense.

In upholding the Board’s determination that the marks OLYMPIC and OLYMPIC KIDS create a different commercial impression, the Federal Circuit noted that: “Whether marks are ‘different’ is a less stringent criterion than whether the marks are likely to cause confusion.” *O-M Bread, Inc. v. United States Olympic Committee*, 65 F.3d 933, 36 USPQ2d 1041, 1045 (Fed. Cir. 1995). Thus, while in the context of likelihood of confusion disclaimed or weak portions of a mark are not relevant, the analysis of whether two marks are “different” for purposes of the *Morehouse* defense requires that “no portion of a mark may be ignored in comparing the marks as whole.” *Id.*

Under this standard, the mark THE ALARIS GROUP, INC. *is* different from the single word mark ALARIS and is certainly different from ALARIS SELECT, ALARIS ADVANTAGE and ALARISWARE. These marks look different, sound different and mean different things. Also, whereas the original mark, THE ALARIS GROUP, INC., is clearly recognizable as a company trade name, the other marks do not create this impression. Thus, the Board should apply *O-M Bread, Inc.* and find that the *Morehouse* defense is unavailing for any of the

challenged oppositions or the challenged registration. At the very least, Alaris Group has failed to demonstrate the absence of a genuine issue of material fact and entitlement to judgment as a matter of law.

2. The *Morehouse* Defense Does Not Apply Because the “Consulting Services” of the Relied Upon Registration are Not “The Same or Substantially Identical” To “Medical Consulting Services,” “Franchise Services” or “Software”

Just as the *Morehouse* defense requires the marks to be identical, it also requires the goods or services to be identical. Related goods do not qualify as “the same or substantially identical.” See *La Fara Importing Co. v. F. Lil de Cesso di Filippo Fara S. Martino S.p.A.*, 8 USPQ2d 1143, 1147 (TTAB 1988)(rejecting *Morehouse* defense where challenged registration for identical mark listed some goods found in relied upon registration but also listed additional related goods); *Mason Engineering and Design Corp. v. Mateson Chemical Corp.*, 225 USPQ 956, 961 (TTAB 1985)(rejecting *Morehouse* defense because the “air purification services” of the challenged application are not substantially identical to the “general purpose odor and fume absorbent chemical preparation” set forth in the earlier registration); *Liberty & Co., Ltd. v. Liberty Trouser Co. Inc.*, 216 USPQ 65, 68 (TTAB 1982). *Liberty & Co., Ltd. v. Liberty Trouser Co. Inc.*, 216 USPQ 65, 68 (TTAB 1982)(rejecting *Morehouse* defense because although the goods of the challenged application were “part of the same as and otherwise closely related to” the relied upon registration, some of the goods were not the same or substantially identical); *Jacks-Evans Manufacturing Co. v. Jaybee Manufacturing Corp.*, 481 F.2d 1342, 179 USPQ 81, 82–83 (CCPA 1973)(rejecting *Morehouse* defense where “padlocks” not the same or substantially identical to goods of earlier registrations of identical mark); *Key Chemicals, Inc. v. Kelite Chemicals Corp.*, 464 F.2d 1040, 175 USPQ 99, 101 (CCPA 1972)(rejecting *Morehouse*

defense where later registration for identical mark listed goods more broadly than relied upon registration).

In the present case, Alaris Group attempts to rely upon its earlier registration of THE ALARIS GROUP, INC., which identifies a Class 42 registration for “Consulting services in the fields of medical and vocational rehabilitation primarily responding to the needs of the workers compensation industry.” The recent emphasis of the term “medical” in the newer applications and registration, and the re-classification of the consulting services from Class 42 (“Computer & Scientific”) to Class 44 (“Medical, beauty and agricultural”) are clear differences in the recited services. Moreover, the addition of franchise services and software goods to some of the marks is an even clearer departure from the original listing of services. A comparison of these registrations and applications is below:

Non-Challenged Registration	Class	Services
THE ALARIS GROUP, INC. (RN: 2510667)	042	Consulting services in the fields of medical and vocational rehabilitation primarily responding to the needs of the workers compensation industry.

Challenged Applications & Registration	Class	Goods / Services
ALARIS SELECT (SN: 78744914)	035	Franchise services , namely, offering technical and business management assistance in the establishment and operation of medical consulting primarily for the workers compensation industry
	044	Medical consulting services in the field of medical and vocational rehabilitation primarily responding to the needs of the workers compensation industry
ALARIS (SN: 78945352)	035	Franchise services , namely, offering technical and business management assistance in the establishment and operation of medical consulting primarily for the workers compensation industry

ALARIS ADVANTAGE (SN: 78945025)	035	Franchise services , namely, offering technical and business management assistance in the establishment and operation of medical consulting primarily for the workers compensation industry
	044	Medical consulting services in the field of medical and vocational rehabilitation primarily responding to the needs of the workers compensation industry
ALARISWARE (SN: 78937067)	09	Computer software for the collection, editing, organizing, modifying, book marking, transmission, storage, reporting and sharing of data and information namely in the field of medical consulting
ALARIS (RN: 2930177)	044	Medical consulting services in the fields of medical and vocational rehabilitation primarily responding to the needs of the workers compensation industry

It is clear that Alaris Group cannot possibly carry its burden to demonstrate that both the marks and the goods/services of the relied upon and challenged applications and registration are “the same or substantially identical.” If the Board is satisfied that Alaris Group cannot demonstrate this burden under either prong, Alaris Group’s motion for leave to amend must be denied as futile. *See Mitek Corp. v. Woods Indus.*, 41 U.S.P.Q.2d 1307, 1309 (citing *Foman v. Davis*, 371 U.S. 178, 182 (U.S. 1962) for “futility” as an acceptable basis for denying leave to amend) & 1310 (whether an amendment would be futile depends upon whether the amended pleading would withstand a motion to dismiss).²; *Kemin Foods, L.C. v. Pigmentos Vegetales Del Centro S.A. De C.V.*, 464 F.3d 1339, 1353 (Fed. Cir. 2006)(upholding district court’s denial of leave to amend on the basis of futility based upon the evidence made of record); *Cultor Corp. v. A.E. Staley Mfg. Co.*, 224 F.3d 1328, 1333 (Fed. Cir. 2000)(same).

² *Foman v. Davis*, 371 U.S. 178, 182 (U.S. 1962) lists the following as acceptable reasons for denying leave to amend: “undue delay, bad faith or dilatory motive on the part of the movant, repeated failure to cure deficiencies by amendments previously allowed, undue prejudice to the opposing party by virtue of allowance of the amendment, futility of amendment, etc.”

III. ALARIS GROUP'S MOTION IN THE ALTERNATIVE FOR AN ORDER COMPELLING DISCOVERY OR DISMISSING THE PROCEEDINGS SHOULD BE DENIED AS MOOT AND BECAUSE ALARIS GROUP COMES TO THE BOARD WITH UNCLEAN HANDS

Alaris Group also moves in the alternative for an order to compel discovery and, in the alternative to this alternative, for a motion for sanctions for alleged discovery abuses. These alternative motions are moot, as every request by Alaris Group has now been supplied to them. A privilege log and party-signature attesting to the veracity of the Answers to Alaris Group's interrogatories is attached hereto.³ [True Decl. ¶¶ 3, 10, & 12].

Moreover, Alaris Group's assertion that Cardinal failed to respond to its Second Set of Interrogatories is utterly false. This Motion was filed on February 19, 2008, and a "corrected" Motion was filed on February 20, 2008. On February 19, 2008 Cardinal provided Alaris Group with an emailed courtesy copy of its responses to the Second Set of Interrogatories and followed up by serving it with a hard copy mailed the same day and signed by Cardinal. [True Decl. ¶11]. Incredibly, the "corrected" motion did not correct or even clarify Alaris Group's erroneous assertion that Cardinal had failed to provide responses to the Second Set of Interrogatories. To this day, after having the discovery responses for over a month, Alaris Group continues to maintain its motion to compel discovery and has failed to correct or clarify the record with regard to its false assertions.

IV. ALARIS GROUP'S MOTION FOR LEAVE TO AMEND ITS ANSWER TO ADD A COUNTERCLAIM FOR FRAUD SHOULD BE DENIED

Finally, Alaris Group includes yet another motion in the alternative for leave to amend its answer to add a compulsory counterclaim attacking the validity of Cardinal's Reg. No. 2279724 for ALARIS on the grounds of fraud on the PTO. Alaris Group fails to demonstrate that it

³ While Cardinal has now served Alaris Group with party signatures attesting to the veracity of all interrogatory responses, Alaris Group has yet to provide its own party signature for any of its responses to Cardinal's interrogatories.

developed grounds for this counterclaim during the discovery process, as required by TBMP 313.04 and 37 CFR § 2.106(b)(2). Here again, Alaris Group maintains that Cardinal did not provide the very discovery Alaris Group received by email the day before it filed the “corrected” motion. And, indeed, that discovery provided evidence of substantial use by Cardinal of its ALARIS mark on the goods and services enumerated in the registrations.

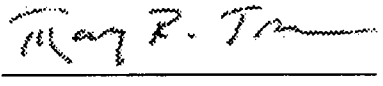
Alaris Group’s only other basis for asserting that Cardinal has defrauded the PTO consists of the anecdotal evidence of two press releases that it contends do not themselves set forth Cardinal’s entire listing of goods and services—as if the absence of a long list of goods and services from a press release is some how proof that these goods and services were not offered under the mark. Neither of these “grounds” are credible “reasons to suspect” anything. Accordingly, the Board should recognize this motion as nothing more than “piling on” and deny it.

Conclusion

Alaris Group’s Motion for Summary Judgement on laches, and its grab bag of motions in the alternative, are all utterly without merit. Cardinal respectfully requests the Board to deny the Motions in their entirety, and further requests that the discovery period be extended by ninety (90) days, with all other dates reset accordingly, in order to allow time for meaningful discovery on the merits.

Dated: March 25, 2008

Respectfully submitted,

By: 

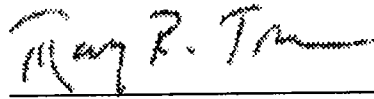
Joseph R. Dreitler
Mary R. True
BRICKER & ECKLER LLP
100 S. Third Street
Columbus, Ohio 43215
Telephone: (614) 227-2347
Facsimile: (612) 227-2390
Email: jdreitler@bricker.com
mtrue@bricker.com

Attorneys for Opposer
Cardinal Health 303, Inc.

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing was served upon the following attorney of record for Applicant by electronic and First Class Mail, this 25th day of March 2008:

Kristine Boylan
Merchant & Gould
3200 IDS Center
80 South 8th Street
Minneapolis, Minnesota 55402
kboylan@merchantgould.com

A handwritten signature in black ink, appearing to read "Mary R. True", is written over a horizontal line.

Mary R. True

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

- | | | |
|------------------------------|---|------------------------------|
| 1. CARDINAL HEALTH 303, INC. | : | |
| Opposer | : | |
| v. | : | Opposition No.: 91-177,234 |
| THE ALARIS GROUP, INC. | : | |
| Applicant | : | |
| | : | |
| 2. CARDINAL HEALTH 303, INC. | : | |
| Opposer | : | |
| v. | : | Opposition No.: 91-177,365 |
| THE ALARIS GROUP, INC. | : | |
| Applicant | : | |
| | : | |
| 3. CARDINAL HEALTH 303, INC. | : | |
| Opposer | : | |
| v. | : | Opposition No.: 91-177,366 |
| THE ALARIS GROUP, INC. | : | |
| Applicant | : | |
| | : | |
| 4. CARDINAL HEALTH 303, INC. | : | |
| Opposer | : | |
| v. | : | Opposition No.: 91-177,367 |
| THE ALARIS GROUP, INC. | : | |
| Applicant | : | |
| | : | |
| 5. CARDINAL HEALTH 303, INC. | : | |
| Petitioner | : | |
| v. | : | Cancellation No.: 92-048,172 |
| THE ALARIS GROUP, INC. | : | |
| Registrant. | : | |

DECLARATION OF MARY R. TRUE

I, Mary R. True, state as follows:

1. I am a partner with the law firm of Bricker & Eckler LLP and am one of the attorneys representing Opposer/Petitioner Cardinal Health 303, Inc. ("Cardinal Health") in these proceedings.
2. Cardinal became aware of the ALARIS SELECT application in early 2007 through its Counsel's monitoring of the *Official Gazette*, and likewise learned of the ALARIS, ALARIS

ADVANTAGE and ALARISWARE application upon their publication. Extensions of time to oppose each mark were filed during the Opposition periods of each application. Attached as Exhibit A are true and accurate copies of the prosecution histories of these applications, indicating the dates published for opposition, the dates in which an extension of time to oppose was sought, and the dates in which an Opposition proceeding was actually instituted.

3. Through subsequent research into the company's activities in March of 2007, Cardinal learned of Alaris Group's prior registration of ALARIS. Attached as Exhibit B is a true and accurate copy of the Cardinal Health Privilege Log, describing a letter from Thomas A. Runk, Esq. to Obi Iloputaife, Esq., dated March 30, 2007. The substance of this letter is protected by attorney/client privilege and is attorney work product.

4. After filing the appropriate extensions of time in which to oppose the four recent Alaris Group applications, Counsel for Cardinal contacted Counsel for Alaris Group to discuss possible settlement.

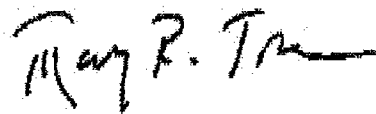
5. Attached as Exhibit C is a true and accurate copy of a "Mark Co-Existence Agreement." Proposed by Counsel for Alaris Group.

6. Attached as Exhibit D is a true and accurate copy of a letter from Counsel for Cardinal to Counsel for Alaris, granting a request by Counsel for Alaris for a thirty (30) day extension of time to file its Answer in each of the four pending Oppositions.

7. Cardinal's current Counsel took over Cardinal's representation in August 2007, and on August 24, 2007 wrote to Alaris Group's Counsel with comments regarding the June 15, 2007 proposed co-existence agreement. Attached as Exhibit E is a true and accurate copy of the August 24, 2007 letter.

8. Attached as Exhibit F is a true and accurate copy of a letter from Counsel for Alaris Group to Counsel for Cardinal, dated September 10, 2007.
9. Attached as Exhibit G is a true and accurate copy of a letter from Counsel for Cardinal to Counsel for Alaris Group, dated September 14, 2007.
10. Attached as Exhibit H is a true and accurate copy of the party signature attesting to Cardinal's Response and Supplemental Response to Alaris Group's First Set of Interrogatories.
11. Attached as Exhibit I is a true and accurate copy of an email and attachment sent February 19, 2008, on behalf of Counsel for Cardinal to Counsel for Alaris Group, providing a courtesy copy of Cardinal's responses to the Second Set of Interrogatories. The hard copy of this discovery was mailed on the same day.
12. Attached as Exhibit J is a true and accurate copy of the party signature attesting to Cardinal's Response to Alaris Group's Second Set of Interrogatories.

I declare under penalty of perjury that the foregoing is true and accurate to the best of my knowledge



Mary R. True

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2008-03-21 14:48:10 ET

Serial Number: 78744914 Assignment Information Trademark Document Retrieval

Registration Number: (NOT AVAILABLE)

Mark

Alaris Select

(words only): ALARIS SELECT

Standard Character claim: Yes

Current Status: An opposition is now pending at the Trademark Trial and Appeal Board.

Date of Status: 2007-05-10

Filing Date: 2005-11-01

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 117

Attorney Assigned:
ORTIGA RAMONA F

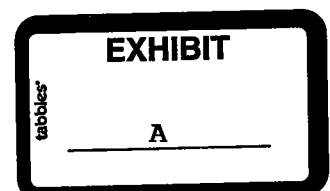
Current Location: 650 -Publication And Issue Section

Date In Location: 2006-12-18

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Alaris Group, Inc., The

Address:
Alaris Group, Inc., The
P.O. Box 24855



Edina, MN 55424

United States

Legal Entity Type: Corporation

State or Country of Incorporation: Minnesota

Phone Number: 952-925-9343

Fax Number: 952-397-9180

GOODS AND/OR SERVICES

International Class: 044

Class Status: Active

Medical consulting services in the field of medical and vocational rehabilitation primarily responding to the needs of the workers compensation industry

Basis: 1(a)

First Use Date: 2003-04-01

First Use in Commerce Date: 2004-04-15

ADDITIONAL INFORMATION

Prior Registration Number(s):

2510667

2930177

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2007-05-10 - Opposition instituted for Proceeding

2007-02-15 - Extension Of Time To Oppose Received

2007-01-23 - Published for opposition

2007-01-03 - Notice of publication

2006-12-01 - Law Office Publication Review Completed

2006-11-29 - Approved for Pub - Principal Register (Initial exam)

2006-11-21 - Teas/Email Correspondence Entered

2006-11-21 - Communication received from applicant

2006-11-21 - Assigned To LIE

2006-11-03 - TEAS Change Of Correspondence Received

2006-11-03 - TEAS Response to Office Action Received

2006-05-05 - Non-final action e-mailed

2006-05-05 - Non-Final Action Written

2006-05-04 - Assigned To Examiner

2005-11-07 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Katheryn A Andresen

Correspondent

Kristine M. Boylan

Merchant & Gould P.C.

80 South Eighth Street Ste 3200

Minneapolis, MN 55402-2215

Phone Number: 952-548-6060

Fax Number: 952-548-6069

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2008-03-21 14:49:57 ET

Serial Number: 78945352 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: (NOT AVAILABLE)

Mark

ALARIS

(words only): ALARIS

Standard Character claim: Yes

Current Status: An opposition is now pending at the Trademark Trial and Appeal Board.

Date of Status: 2007-05-17

Filing Date: 2006-08-04

Filed as TEAS Plus Application: Yes

Currently TEAS Plus Application: Yes

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 101

Attorney Assigned:
FAHRENKOPF PAUL E

Current Location: 650 -Publication And Issue Section

Date In Location: 2007-01-30

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. The Alaris Group, Inc.

Address:

The Alaris Group, Inc.
P.O. Box 24855
Edina, MN 55424
United States

Legal Entity Type: Corporation**State or Country of Incorporation:** Minnesota**Phone Number:** 952-925-9343**Fax Number:** 952-397-9180

GOODS AND/OR SERVICES

International Class: 035**Class Status:** Active

Franchise services, namely, offering technical and business management assistance in the establishment and operation of medical consulting primarily for the workers compensation industry

Basis: 1(b)**First Use Date:** (DATE NOT AVAILABLE)**First Use in Commerce Date:** (DATE NOT AVAILABLE)

ADDITIONAL INFORMATION

Prior Registration Number(s):

2510667

2930177

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2008-01-08 - Assigned To Examiner

2007-05-17 - Opposition instituted for Proceeding

2007-03-07 - Extension Of Time To Oppose Received

2007-03-06 - Published for opposition

2007-02-14 - Notice of publication

2007-01-22 - Law Office Publication Review Completed

2007-01-22 - Assigned To LIE

2006-12-20 - Approved for Pub - Principal Register (Initial exam)

2006-12-19 - Assigned To Examiner

2006-08-09 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Katheryn A. Andresen

Correspondent

Kristine M. Boylan

Merchant & Gould

80 S 8th St Ste 3200

Minneapolis, MN 55402

Phone Number: 952-548-6060

Fax Number: 952-548-6069

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2008-03-21 14:52:06 ET

Serial Number: 78945025 Assignment Information Trademark Document Retrieval

Registration Number: (NOT AVAILABLE)

Mark

ALARIS Advantage

(words only): ALARIS ADVANTAGE

Standard Character claim: Yes

Current Status: An opposition is now pending at the Trademark Trial and Appeal Board.

Date of Status: 2007-05-17

Filing Date: 2006-08-04

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 101

Attorney Assigned:
PARKER JUSTINE D

Current Location: 650 -Publication And Issue Section

Date In Location: 2007-01-30

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. The Alaris Group, Inc.

Address:
The Alaris Group, Inc.
P.O. Box 24855

Edina, MN 55424

United States

Legal Entity Type: Corporation

State or Country of Incorporation: Missouri

Phone Number: 952-925-9343

Fax Number: 952-397-9180

GOODS AND/OR SERVICES

International Class: 035

Class Status: Active

Franchise services, namely, offering technical and business management assistance in the establishment and operation of medical consulting primarily for the workers compensation industry

Basis: 1(b)

First Use Date: (DATE NOT AVAILABLE)

First Use in Commerce Date: (DATE NOT AVAILABLE)

International Class: 044

Class Status: Active

Medical consulting services in the field of medical and vocational rehabilitation primarily responding to the needs of the workers compensation industry

Basis: 1(b)

First Use Date: (DATE NOT AVAILABLE)

First Use in Commerce Date: (DATE NOT AVAILABLE)

ADDITIONAL INFORMATION

Disclaimer: "advantage"

Prior Registration Number(s):

2510667

2930177

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2008-01-08 - Assigned To Examiner

2007-05-17 - Opposition instituted for Proceeding

2007-03-07 - Extension Of Time To Oppose Received

2007-03-06 - Published for opposition

2007-02-14 - Notice of publication

2007-01-22 - Law Office Publication Review Completed

2007-01-22 - Assigned To LIE

2006-12-20 - Approved for Pub - Principal Register (Initial exam)

2006-12-19 - Assigned To Examiner

2006-08-08 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Katheryn A. Andresen

Correspondent

Kristine M. Boylan

Merchant & Gould

80 S 8th St Ste 3200

Minneapolis, MN 55402

Phone Number: 952-548-6060

Fax Number: 952-548-6069

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2008-03-21 14:52:46 ET

Serial Number: 78937067 Assignment Information Trademark Document Retrieval

Registration Number: (NOT AVAILABLE)

Mark

ALARIS *ware*

(words only): ALARISWARE

Standard Character claim: No

Current Status: An opposition is now pending at the Trademark Trial and Appeal Board.

Date of Status: 2007-05-17

Filing Date: 2006-07-25

Filed as TEAS Plus Application: Yes

Currently TEAS Plus Application: Yes

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 101

Attorney Assigned:
MICHELI ANGELA M

Current Location: 650 -Publication And Issue Section

Date In Location: 2007-02-01

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. The Alaris Group, Inc.

Address:

The Alaris Group, Inc.
P.O. Box 24855
Edina, MN 55424
United States

Legal Entity Type: Corporation**State or Country of Incorporation:** Minnesota**Phone Number:** 952-925-9343**Fax Number:** 952-397-9180

GOODS AND/OR SERVICES

International Class: 009**Class Status:** Active

Computer software for the collection, editing, organizing, modifying, book marking, transmission, storage, reporting and sharing of data and information namely in the field of medical consulting

Basis: 1(b)**First Use Date:** (DATE NOT AVAILABLE)**First Use in Commerce Date:** (DATE NOT AVAILABLE)

ADDITIONAL INFORMATION

Description of Mark: The mark consists of "ALARIS" in all caps immediately followed by "ware" in lower case italics.

Prior Registration Number(s):

2510667

2930177

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2008-01-08 - Assigned To Examiner

2007-05-17 - Opposition instituted for Proceeding

2007-03-07 - Extension Of Time To Oppose Received

2007-03-06 - Published for opposition

2007-02-14 - Notice of publication

2007-01-22 - Law Office Publication Review Completed

2007-01-22 - Assigned To LIE

2006-12-20 - Approved for Pub - Principal Register (Initial exam)

2006-12-19 - Assigned To Examiner

2006-07-29 - Notice Of Pseudo Mark Mailed

2006-07-28 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

KATHERYN A ANDRESEN

Correspondent

Kristine M. Boylan

Merchant & Gould

80 S 8th St Ste 3200

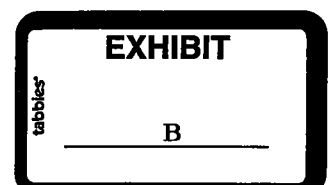
Minneapolis, MN 55402

Phone Number: 952-548-6060

Fax Number: 952-548-6069

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

- | | | |
|------------------------------|---|------------------------------|
| 1. CARDINAL HEALTH 303, INC. | : | |
| Opposer | : | |
| v. | : | Opposition No.: 91-177,234 |
| THE ALARIS GROUP, INC. | : | |
| Applicant | : | |
| 2. CARDINAL HEALTH 303, INC. | : | |
| Opposer | : | |
| v. | : | Opposition No.: 91-177,365 |
| THE ALARIS GROUP, INC. | : | |
| Applicant | : | |
| 3. CARDINAL HEALTH 303, INC. | : | |
| Opposer | : | |
| v. | : | Opposition No.: 91-177,366 |
| THE ALARIS GROUP, INC. | : | |
| Applicant | : | |
| 4. CARDINAL HEALTH 303, INC. | : | |
| Opposer | : | |
| v. | : | Opposition No.: 91-177,367 |
| THE ALARIS GROUP, INC. | : | |
| Applicant | : | |
| 5. CARDINAL HEALTH 303, INC. | : | |
| Petitioner | : | |
| v. | : | Cancellation No.: 92-048,172 |
| THE ALARIS GROUP, INC. | : | |
| Registrant. | : | |

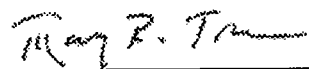


CARDINAL HEALTH 303, INC.'S PRIVILEGE LOG OF DOCUMENTS
RESPONSIVE TO THE ALARIS GROUP, INC.'S REQUESTS FOR
DOCUMENTS FOR WHICH A CLAIM OF ATTORNEY/CLIENT PRIVILEGE
AND/OR ATTORNEY WORK PRODUCT IS MADE

Doc. Prod. No.	Description	Date
CHAL02741- CHAL02758	Thomas A. Runk, Esq. to Obi Iloputaife, Esq.	3/30/2007

Dated: March 25, 2008

By: _____



Joseph R. Dreitler
Mary R. True
BRICKER & ECKLER LLP
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Columbus, Ohio 43215
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Facsimile: (612) 227-2390
Email: jdreitler@bricker.com
mtrue@bricker.com

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Stephen J. Strauss

Thomas H. Majcher

Thomas A. Runk

Michael S. Elkind

Gary M. Anderson

Ronald E. Perez

I. Morley Drucker

David G. Parkhurst

John V. Hanley

John K. Fitzgerald

Paul Y. Feng

Gunther O. Hanke

James Juo

David J. Pitman

Douglas R. Peterson

Michael J. Moffatt

Jennifer L. Webber

Michael E. Hoffman

Jessie K. Reider

Jessica Brookhart-Knost

Senior Counsel

Richard A. Bardin

Of Counsel

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Leonard D. Messinger

Scott R. Hansen

Katherine L. McDaniel

Robert W. Fulwider

(1903-1979)

Warren L. Patton

(1912-1985)

F.A. Utecht (Ret.)

jreider@fulpat.com

August 2, 2007

VIA U.S. MAIL

Katheryn A. Andresen, Esq.
BSSFA
5050 France Avenue South, Suite 200
Edina, MN 55410

Kristine Boylan, Esq.
Merchant & Gould, PC
3200 IDS Center
80 South 8th Street
Minneapolis, MN 55402

Re: Cardinal Health 303, Inc. v. The Alaris Group, Inc.
TTAB Opposition Nos.: 91177365; 91177366; 91177367; 91177234
Our Docket Nos.: 76524; 76745; 76746; 76747

Dear Ms. Andresen and Ms. Boylan:


Enclosed please find service copies of the Consent Motions to Extend the Discovery, Testimony and Trial Periods for the above referenced matters before the Trademark Trial and Appeal Board.

Further to my conversation with Ms. Andresen this afternoon, Ms. Boylan will submit consent motions to extend The Alaris Group's time to answer by thirty (30) days, in all four pending oppositions. If my understanding of the foregoing is at all inaccurate, please let me know at your earliest convenience. I look forward to receiving confirmation of filing in advance of the current August 25, 2007 deadline.

Please do not hesitate to contact me with any questions.

Sincerely,

FULWIDER PATTON LLP


Jessie K. Reider

JKR
Enclosures
189938.1

EXHIBIT

D



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ESTTA Tracking number: **ESTTA154615**

Filing date: **08/02/2007**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding.	91177234
Applicant	Plaintiff Cardinal Health 303, Inc.
Other Party	Defendant Alaris Group, Inc., The

Motion for an Extension of Discovery or Trial Periods With Consent

The Close of Discovery is currently set to close on 02/01/2008. Cardinal Health 303, Inc. requests that such date be extended for 30 days, or until 03/02/2008, and that all subsequent dates be reset accordingly.

Discovery Period to Close : 03/02/2008

Thirty-day testimony period for party in position of plaintiff to close : 05/31/2008

Thirty-day testimony period for party in position of defendant to close : 07/30/2008

Fifteen-day rebuttal testimony period to close : 09/13/2008

The grounds for this request are as follows:

- *Parties are engaged in settlement discussions*

Cardinal Health 303, Inc. has secured the express consent of all other parties to this proceeding for the extension requested herein.

Cardinal Health 303, Inc. has provided an e-mail address herewith for itself and for the opposing party so that any order on this motion may be issued electronically by the Board.

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Respectfully submitted,

/jkr/

Jessie K. Reider

docketla@fulpat.com, jreider@fulpat.com

kboylan@merchantgould.com, sbrazfield@merchantgould.com,

dockmpls@merchantgould.com, kandresen@bssda.com

08/02/2007

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ESTTA Tracking number: **ESTTA154612**

Filing date: **08/02/2007**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding.	91177367
Applicant	Plaintiff Cardinal Health 303, Inc.
Other Party	Defendant The Alaris Group, Inc.

Motion for an Extension of Discovery or Trial Periods With Consent

The Close of Discovery is currently set to close on 02/01/2008. Cardinal Health 303, Inc. requests that such date be extended for 30 days, or until 03/02/2008, and that all subsequent dates be reset accordingly.

Discovery Period to Close : 03/02/2008

Thirty-day testimony period for party in position of plaintiff to close : 05/31/2008

Thirty-day testimony period for party in position of defendant to close : 07/30/2008

Fifteen-day rebuttal testimony period to close : 09/13/2008

The grounds for this request are as follows:

- *Parties are engaged in settlement discussions*

Cardinal Health 303, Inc. has secured the express consent of all other parties to this proceeding for the extension requested herein.

Cardinal Health 303, Inc. has provided an e-mail address herewith for itself and for the opposing party so that any order on this motion may be issued electronically by the Board.

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Respectfully submitted,

/jkr/

Jessie K. Reider

docketla@fulpat.com, jreider@fulpat.com

kboylan@merchantgould.com, sbrazfield@merchantgould.com,

dockmpls@merchantgould.com, kandresen@bssda.com

08/02/2007

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Electronic System for Trademark Trials and Appeals

Receipt

Your submission has been received by the USPTO.
The content of your submission is listed below.
You may print a copy of this receipt for your records.

ESTTA Tracking number: **ESTTA154609**

Filing date: **08/02/2007**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding.	91177366
Applicant	Plaintiff Cardinal Health 303, Inc.
Other Party	Defendant The Alaris Group, Inc.

Motion for an Extension of Discovery or Trial Periods With Consent

The Close of Discovery is currently set to close on 02/01/2008. Cardinal Health 303, Inc. requests that such date be extended for 30 days, or until 03/02/2008, and that all subsequent dates be reset accordingly.

Discovery Period to Close :	03/02/2008
Thirty-day testimony period for party in position of plaintiff to close :	05/31/2008
Thirty-day testimony period for party in position of defendant to close :	07/30/2008
Fifteen-day rebuttal testimony period to close :	09/13/2008

The grounds for this request are as follows:

- *Parties are engaged in settlement discussions*

Cardinal Health 303, Inc. has secured the express consent of all other parties to this proceeding for the extension requested herein.

Cardinal Health 303, Inc. has provided an e-mail address herewith for itself and for the opposing party so that any order on this motion may be issued electronically by the Board.

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Respectfully submitted,

/jkr/

Jessie K Reider

docketla@fulpat.com, jreider@fulpat.com

kboylan@merchantgould.com, sbrazfield@merchantgould.com,

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08/02/2007

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding.	91177365
Applicant	Plaintiff Cardinal Health 303, Inc.
Other Party	Defendant The Alaris Group, Inc.

Motion for an Extension of Discovery or Trial Periods With Consent

The Close of Discovery is currently set to close on 02/01/2008. Cardinal Health 303, Inc. requests that such date be extended for 30 days, or until 03/02/2008, and that all subsequent dates be reset accordingly.

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Respectfully submitted,

/jkr/

Jessie K. Reider

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September 14, 2007

VIA EMAIL AND U.S. MAIL

Katheryn A. Andresen, Esq.
BSSDA
5050 France Avenue South, Suite 200
Edina, MN 55410

RE: Cardinal Health 303, Inc. – four (4) oppositions to The
Alaris Group, Inc. applications of Alaris

Dear Ms. Andresen:

We are in receipt of your letter of September 10, 2007. While we would prefer to resolve this matter amicably, your client's position makes it difficult to find any common ground for settlement at this time. Accordingly, we understand that the Oppositions will proceed, and we will await your answers which are due to be filed on September 24, 2007. However, be assured that we are always open to revisiting settlement negotiations if your client changes its current position.

Sincerely,

Joseph R. Dreitler

JRD/maj

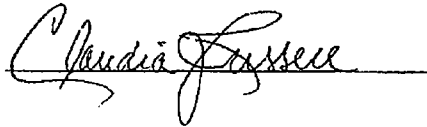
cc: Kristine Boylan, Esq.

EXHIBIT

G

VERIFICATION

I have reviewed the foregoing responses to Opposer/Petitioner's Responses and Supplemented Responses to Applicant/Registrant's First Set of Interrogatories and find them to be true, accurate, and complete to the best of my knowledge, information, and belief.

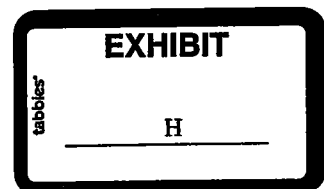


CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing was served this ___th day of March, 2008 by first class mail, postage prepaid, and electronic mail on:

Kristine Boylan
Merchant & Gould
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Minneapolis, Minnesota 55402
kboylan@merchantgould.com

One of the Attorneys for
Opposer/Petitioner
Cardinal Health 303, Inc.



Krabacher, Gregory

From: Ross, Sarah
Sent: Tuesday, February 19, 2008 11:24 AM
To: 'KBoylan@merchantgould.com'
Subject: Petitioner/Opposer's Responses to Registrant/Applicant's Second Set of Interrogatories

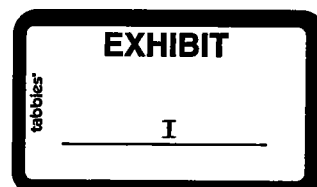
Attachments: Cardinal 303 v. Alaris Group Opposition.pdf



Cardinal 303 v.
Alaris Group O...

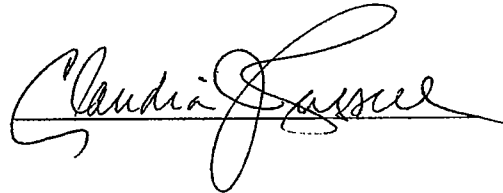
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VERIFICATION

I have reviewed the foregoing responses to Opposer/Petitioner's Responses to Applicant/Registrant's Second Set of Interrogatories and find them to be true, accurate, and complete to the best of my knowledge, information, and belief.



CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing was served this ___th day of February, 2008 by first class mail, postage prepaid, and electronic mail on:

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One of the Attorneys for
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